Docket and File.

Davis Wright Tremaine LLP

27th Floor
1633 Broadway
New York, NY 10019-6708

G. Roxanne Elings
(212) 603-6416 tel
(212) 379-5226 fax

roxanneelings@dwt.com

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VIA EMAIL Abrams NYSDChambers@nysd.uscourts.gov
The Honorable Ronnie Abrams
United States District Judge
United States District Court, SDNY
40 Foley Square, Room 2203
New York, NY 10007

Re: Juicy Couture, Inc. v. Bella International Limited, et al.
Civil Action No. 12-CV-05801 (RA)

Dear Honorable Judge Abrams:

As you know, we represent plaintiff Juicy Couture, Inc. ("Plaintiff" or "Juicy Couture") in the above-captioned action. We are writing in response to the February 15, 2013 and February 19, 2013 letters of Gregg A. Paradise, counsel to the defendants in this action ("Defendants"), as well as to the declaration of Edmund Yeung submitted by defendants and in further response to this Court's request for decisions that would support this Court's authority to exercise jurisdiction over websites with a foreign country code top-level domain (or "gTLD").

In their February 15, 2013 letter, Defendants object to entry of Exhibit 32 to the deposition of Suen John. This is a "Style Book" associated with Defendants' Juicy Girl brand, rather than Plaintiff's marketing materials as Mr. Paradise stated, and that this same document was authenticated at the preliminary injunction hearing on Thursday, February 14, 2013 (the "PI Hearing") and admitted into evidence by Your Honor. We do not disagree with Defendants' remaining objections. We also do not object to entry of Defendants' Exhibit 1, given Defendants' submission of the Declaration of Edmund Yeung earlier today.

Additionally, at the PI Hearing, Your Honor requested decisions from any cases outside of the default judgment context that supported the Court's ability to order that juicygirl.com.hk (the "Juicy Girl Domain") be disabled or Defendants otherwise be enjoined form operating the same, despite the fact that the Juicy Girl Domain was registered abroad under a foreign country code gTLD. At the time, we informed Your Honor that, other than cases where a default judgment had been granted, we were unaware of any such cases. Upon review of our papers and conducting additional research, we respectfully point the Court to the following relevant cases, including one that we cited in our reply brief.

In its Complaint (at 20-21), Notice of Motion for Preliminary Injunction and Proposed Findings of Fact and Conclusions of Law (at 29), Plaintiff respectfully requested, *inter alia*, that (1) Defendants be enjoined using Plaintiff's marks or any counterfeit, copy or colorable imitation thereof in connection with the offer for sale and/or sale of merchandise not the genuine products of Plaintiff, passing off such infringing products as Plaintiff's and/or shipping or distributing such infringing products; (2) Defendants and their various affiliates be enjoined from "utilizing the Infringing Domain Names and registering any additional domain names that use or incorporate any of the JUICY Marks" and "operating and/or hosting Defendants' Infringing Websites" and/or (3) that the websites and/or the corresponding domain names be disabled and/or transferred by the appropriate domain name registries and registrars. For injunctive purposes, we believe that the relief requested in (1) is sufficient and within the Court's jurisdictional powers and would include enjoining defendant from utilizing the domain name juicycouture.com.hk and operating and/or hosting a website associated with that domain name to the extent it utilizes Plaintiff's marks or any counterfeit, copy or colorable imitation thereof in connection with the offer for sale of merchandise not the genuine products of plaintiffs.

First, in *A.V. by Versace, Inc. v. Gianni Versace, S.p.A.*, 87 F. Supp. 2d 281 (S.D.N.Y. 2000), a highly contested trademark dispute, the district court held a defendant, Alfonso Versace, in contempt for using the plaintiff's marks in connection with online sales and advertising in violation of a prior preliminary injunction. The prior injunction was broad and prohibited the defendant from using any of the plaintiff's marks in the U.S., but did not explicitly reference use of websites or internet sales. Citing one of the defendant's ".it" domain names as an example, the court explained that "[a]lthough these Internet sites presumably operate from servers in foreign countries, they are accessible by any web browser in the United States," and "[d]espite originating overseas, under federal trademark law, this type of online infringement is deemed to have occurred in the United States, and therefore is plainly covered by the preliminary injunction," which had barred use of the plaintiff's marks in the United States. *Id.* at 294, n.19. The court concluded that there was no "practical alternative other than to require [the defendant] to purge all references to the Infringing Marks throughout cyberspace," and ordered him "to take all reasonable steps to disable every Internet site that in any way employs any of the" plaintiff's marks. *Id.* at 296. In subsequent decisions relating to defendant's further contemptuous conduct, the district court reaffirmed both the extraterritorial reach of the Lanham Act to defendant's conduct, 126 F. Supp. 2d 328 (S.D.N.Y. 2001) and 2006 U.S. Dist. LEXIS 1175 (S.D.N.Y. January 12, 2006), and defendant's obligation to both monitor and stop infringing activity over the internet, irrespective whether such conduct occurred over foreign web sites, 2002 U.S. Dist. LEXIS 16323, at *28 n.13 (S.D.N.Y. September 3, 2003).

Second, in *Partners for Health & Home, L.P. v. Seung Wee Yang*, 2010 U.S. Dist. LEXIS 143476; 98 U.S.P.Q.2D 1462 (C.D. Cal. Sept. 13, 2010), the owner of the mark "PERMA-LIFE" for stainless steel cookware brought a trademark infringement and cybersquatting action based in part on the defendant's registration of the foreign domain names "perma-life.co.kr" and "permalife.co.kr," which he used to sell competing cookware. *Id.* at *21. The court entered a preliminary injunction barring the defendant from using the ".kr" domain names. *Id.* at *2, 30-31.

The court subsequently found that the plaintiff was entitled to summary adjudication on its cyberpiracy claims arising from the defendant's registration and use of the ".kr" domains. *See* 2011 U.S. Dist. LEXIS 130921, at *13 (C.D. Cal. Oct. 28, 2011). The court found, *inter alia*, that a "significant target market for both Plaintiff's cookware and Defendants' cookware is the Korean American community in the Los Angeles area," and that the defendant had linked one of his Korean domains to a domestic ".com" website that also advertised his competing product. *Id.* at *4-5. In granting summary adjudication, the court relied on this court's decision in *Playboy Enterprises, Inc. v. Chuckleberry Pub., Inc.*, 939 F. Supp. 1032 (S.D.N.Y. 1996), where the defendant was barred from using an Italian ".it" domain to sell its product to customers in the United States. *Id.* at *13.

The court then entered a new, broader preliminary injunction prohibiting the defendant from using the plaintiff's mark "for any products anywhere in the world," reasoning that if he used the mark to advertise and sell his products "in either the U.S. or in Korea, it will harm Plaintiff in its business and will affect U.S. commerce." 2011 U.S. Dist. LEXIS 144068, at *12 (C.D. Cal. Dec. 14, 2011). Finally, the court granted summary judgment in favor of the plaintiff and entered a permanent injunction transferring both the "perma-life.co.kr" and "permalife.co.kr" domains to the plaintiff. 2012 U.S. Dist. LEXIS 45116, at *13 (C.D. Cal. Mar. 30, 2012).

A third court has noted that injunction barring defendant from using infringing domain names or operating websites at those domains encompassed domain names under foreign country code gTLDs. *Trudeau v. Lanoue*, No. 04 C 7165, 2005 WL 3299350, at *1 (N.D. Ill. Nov. 30, 2005) (.de (Germany), .jp (Japan) and co.uk (United Kingdom)).

Finally, the Court can enter an order against defendants' use of the JUICY GIRL trademarks in the United States. Defendants can geo-block the Juicy Girl Domain from U.S. visitors. The solution proposed by Defendants –to refrain from taking sales from customers in the U.S. – does nothing to address Defendants' active marketing to U.S. customers and the resultant potential to confuse U.S. customers by marketing to them. The process of geo-blocking or geo-gating is the practice of preventing users from viewing web sites and downloading applications and media based on location. Geo-blocking is accomplished by excluding targeted Internet addresses. Even this solution is imperfect, however. There are multiple workarounds available to geo-blocking that are offered on the internet. *See* Exhibit A hereto (print-out of Google results for software and workarounds to geo-blocking). Yet Juicy Couture submits that in the absence of an order requiring the shutdown of and/or transfer of the Juicy Girl Domain, this solution remains the best option for addressing the potential impact of Defendants' infringing conduct within the United States and to United States' customers.

Defendants' counsel stated during the PI Hearing that defendant Goldstable International Corporation ("Goldstable"), which it admits is a California corporation, is not involved in the distribution of JUICY GIRL-branded products. The facts of record indicate otherwise. The JUICY GIRL-branded goods Defendants sold and shipped into the United States bear a Federal Trade Commission ("FTC") Registered Identification Number (or "RN") registered to Goldstable at an address for a home owned by defendant Jessica Ching Ping Yang and a telephone number associated with Ms. Ching. Declaration of Tamara D. Tarbutton, dated August 17, 2012, ¶¶ 27-31, Ex. T. An RN is issued by the FTC only to a business residing in the U.S. that is engaged in the manufacture, import, distribution or sale of textile, wool or fur products and is used in the place of a label or tag required by U.S. law to be affixed to these products. *Id.* ¶ 28. That Defendants are all closely aligned, the entities all owned by one or both of the individual defendants and all deal in the manufacture and sale of JUICY GIRL merchandise, indicate a clear presence in the United States and even further supports extraterritorial jurisdiction on these facts.

Sincerely,

Davis Wright Tremaine LLP

/s/ G. Roxanne Elings

G. Roxanne Elings

cc: Gregg A. Paradise (gparadise@ldlkm.com)
Bruce H. Sales (bsales@ldlkm.com)

Exhibit A

+You Search Images Maps Play YouTube News Gmail Drive Calendar More

geo-blocking website

Sign in

Web Images Maps Shopping News More Search tools

About 1,370,000 results (0.25 seconds)

Ad related to **geo-blocking website**

Top **Website** Blocker - BarracudaNetworks.com
www.barracudanetworks.com/
Barracuda **Web** Filter: The Leader in **Website** & Spyware Business Security

Geo-blocked Definition from PC Magazine Encyclopedia
www.pcmag.com › Solutions › Encyclopedia
Definition of: **geo-blocked**. **geo-blocked**. (GEOgraphically-BLOCKED) The practice of preventing users from viewing **Web sites** and downloading applications ...

TunnelBear VPN Circumvents **Geoblocking** | PCWorld
www.pcworld.com/.../tunnelbear_vpn_circumvents_**geoblo**...

by Mark O'Neill - in 811 Google+ circles - More by Mark O'Neill
Aug 8, 2012 – This practice is known as **geo-blocking**. For example, **web** services like Hulu, Pandora, Google Voice, and Google Music are not available ...

What Do You Think About **Geo-Blocking** & How Do You Circumvent ...
www.makeuseof.com › Opinion & Polls

by Dave Parrack - in 66 Google+ circles - More by Dave Parrack
Jun 28, 2012 – **Geo-blocking** is practiced by **websites** or **Web** services seeking to keep their content within the confines of a particular territory. **Geo-blocking** is ...

How To Get Around **Geo Blocking** (Very Smart **Website**) - Super User
superuser.com/.../how-to-get-around-**geo-blocking**-very-smart-**websi**...
Nov 19, 2012 – For your reference, here is the **site** I'm trying to purchase the sub from: ... Any help or suggestions to get around this nasty **Geo-blocking** trap are ...

Geoblocking - Dig **Site** Value
digsitevalue.net/k/**geoblocking**
Those living in smaller markets like New Zealand might feel like second-class customers on the **Web**, as desirable services like Hulu and Netflix often exclude ...

Geo-blocking: Fitting a Square Peg in a Round Hole
www.heydary.com › Our Publications
The pop up message is due to "**geo-blocking**", or "geo-fencing", in which a **website** ensures that only the people within a specific geographical region can view ...

Bypass **Geo** IP **Blocking** using our service
www.vpnaccounts.com/bypass-**geo-blocking**.html
Geoblocking is a technology that **web sites** use to prevent visitors from accessing their **web sites** or services on their **site**. They usually block visitors from specific ...

Geolocation software - Wikipedia, the free encyclopedia
en.wikipedia.org/wiki/Geolocation_software
3.1 Criminal investigations; 3.2 Fraud detection; 3.3 **Geo** marketing; 3.4 Regional ... Some **sites** detect the use of proxies and anonymizers, and may either **block** ...

Michael Geist - **Geo-Blocking Sites** a Business Rather Than Legal ...
www.michaelgeist.ca/content/view/5179/135/
Jul 8, 2010 – Dr. Michael Geist is the Canada Research Chair of Internet and E-commerce Law at the University of Ottawa., **geo-blocking** column.

[Avoid **geoblocking** with a VPN | ST4RT-VPN Blog]
www.start-vpn.com/blog/avoid-**geoblocking**/

by Homie Austin - More by Homie Austin
Some Internet **websites** use "**geoblocking**" when they give access to people according to their geographical location. Some **websites** only accepted American ...

News for **geo-blocking website**

Technology pricing inquiry has **geoblocking** in its sights
The Australian Financial Review - 4 days ago
Geoblocking technology is a restriction widely used by technology companies to show consumers and businesses different pricing on **websites** ...

Searches related to **geo-blocking website**

geo web site
website blocked block
how to block a web site
site for blocked sites

1 2 3 4 5 6 7 8 9 10 **Next**

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